



Docket No.: 192403US55X

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/584,182
Applicants: David SUDA, et al.
2nd RCE Filed: March 3, 2003
For: APPARATUS AND METHOD
FOR BAGGING AN ITEM
Group Art Unit: 3721
Examiner: HARMON, C.

SIR:

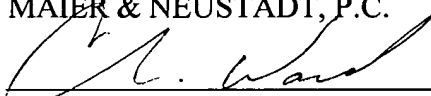
Attached hereto for filing are the following papers:

REPLY BRIEF UNDER 37 C.F.R. § 1.193 (in triplicate)

Our **credit card payment form** in the amount of **\$0.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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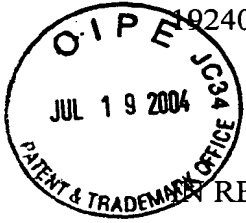
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

David SUDA, et al.

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EXAMINER: HARMON, C.

SERIAL NO: 09/584,182

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GROUP ART UNIT: 3721

FOR: APPARATUS AND METHOD
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REPLY BRIEF UNDER 37 C.F.R. §1.193

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a Reply to the Examiner's Answer mailed May 17, 2004. An Appeal Brief was timely filed on April 7, 2004.

REPLY TO EXAMINER'S ANSWER

Pages 4-5 of the Examiner's Reply sets forth a response to the arguments presented in the Appeal Brief. The response is directed to the Appellants' assertion that there is no motivation to combine the teachings of the Robinson et al. with the teachings of Buchman et al. in order to arrive at the inventions recited in the pending claims.

Firstly, in support of the conclusion that motivation exists to combine the teachings of the Robinson et al. with the teachings of Buchman et al. in order to arrive at the inventions recited in the pending claims, the response asserts that "[i]n this case, one of ordinary skill in

the art is fully capable of rotating a rolled item while inserting it into a tubular structure.”

(Page 4, lines 13-15, of the Examiner's Reply.) However, as noted in MPEP §2143.01, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness. MPEP §2143.01 cites *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) for the assertion that additionally some objection reason must be present to combine the teachings of the references in order to establish a *prima facie* case of obviousness. However, as discussed in detail in the Appeal Brief, the Appellants submit that the references themselves teach away from their combination. Thus, even assuming for the sake of argument that an objective reason existed outside of the teachings of Robinson et al. and Buchman et al., the references themselves would teach away from their combination.

The response then provides several purported motivations, presumably objective reasons, for making the proposed combination, however the motivations are made based upon unsubstantiated comments regarding what is known in the art. For example, the response surmises that “[i]n order to reduce friction or tail interference, it is well known to rotate a rolled product when inserting into a confining structure such as a tube or container. Rolled printed matter such as posters, architectural drawings, Christmas wrapping paper, etc. more easily slide into cardboard tubes etc. for storage or travel and would have been obvious to one of ordinary skill in the art to perform this method.” (Page 4, lines 15-20, of the Examiner's Reply.) The Examiner's Reply does not cite any reference for the teaching of methods of inserting posters, architectural drawings, or Christmas wrapping paper into cardboard tubes.

In fact, based upon Appellants' experiences, Christmas wrapping paper is not inserted within cardboard tubes, but rather is wrapped around the outside of a cardboard tube with shrink-wrapped plastic provided around the outside thereof. Conclusions about how various items, such as posters, architectural drawings, Christmas wrapping paper, etc., are inserted and packaged within contains may not be evident from a simple review of the final product. Absent the citation of a reference specifically showing methods of inserting posters, architectural drawings, or Christmas wrapping paper into cardboard tubes, the Appellants submit that reliance upon such items for the teaching of a motivation is mere conjecture and therefore is improper.

The response supplements the discussion regarding the "known" methods of inserting posters, architectural drawings, Christmas wrapping paper, etc. with a citation to the teachings in Buchman et al. The response indicates that "Buchman et al. teach rotating the rolled product while inserting to avoid tail interference in a confining structure 'only slightly larger than the outside diameter of the roll' (see column 2, lines 5-10)." However, the Appellants submit that, while Buchman et al. teaches rotating a spindle while the spindle is retracted, pulling a roll into a carton, a thorough reading of both of the references as a whole teaches away from the combination of the cited references.

As discussed in detail in the Appeal Brief, the Appellants submit that the references themselves teach away from their combination. For example, Buchman et al. teaches away from the use of a device on the outside of the rolled item during insertion of the item into the carton, since the use of such a device would necessarily increase the size of the carton, thus

increasing the cost of the carton and increasing the space needed to transport and store the carton. Thus, Buchman et al. clearly teaches away from the use of a metal tube (1) as described in Robinson et al. to prevent the item from unrolling (page 3, lines 108-110, of Robinson et al.), but instead opts for simply winding the roll upon direct insertion into a carton. Furthermore, Robinson et al. indicates that the method described therein solves the problems associated with previous insertion manners, thus the addition of the device described in Buchman et al. would be unnecessarily costly and complex. Therefore, one of ordinary skill in the art would not have had an objective reason to combine the teachings of the Robinson et al. with the teachings of Buchman et al. in order to arrive at the inventions recited in the pending claims.

As noted in MPEP §2143.02, the prior art must be considered in its entirety, including disclosures that teach away from the claims. The prior art must be considered as a whole. The rejection cannot simply ignore teachings in the prior art that teach away from the proposed combination. A review of the entirety of the Robinson et al. and Buchman et al. references reveals that the references themselves teach away from their combination, as is discussed in detail in the Appeal Brief.

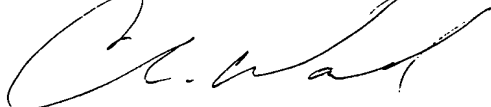
The response also mentions the Chapuis reference and the Holt reference. However, the Appellants note that these references are not cited in any pending rejection of the claims. Furthermore, the Appellants submit that any teachings provided therein do not change the fact that the cited references, i.e. the Robinson et al. and Buchman et al. references, teach away from their combination.

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For the reasons stated above and in the Appeal Brief filed on April 7, 2004, the Appellants maintain their position that the prior art does not render obvious the methods recited in Claims 1 and 3-8. Accordingly, it is respectfully requested that the rejection still pending in the final Office Action be REVERSED.

Respectfully Submitted,

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